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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,038	07/19/2001	Dorit Wolf	3975.003	8471
7590 10/03/2003				
PENDORF & CUTLIF ATTORNEYS AT LAW Post Office Box: 20445 Tampa, FL 33622-0445			EXAMINER ZHOU, SHUBO	
			ART UNIT 1631	PAPER NUMBER

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,038

Applicant(s)

WOLF ET AL.

Examiner

Shubo "Joe" Zhou

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/24/01
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

### ***Preliminary Amendment***

Applicants' preliminary amendment to claim 5, filed 7/19/01, is acknowledged and entered. It's noted that both the original claims and the amended claim 5, both filed on 7/19/01, are in German. The claim 5 (as well as other claims) filed on 9/21/01 in English is taken by the examiner as the English translation of the amended claim 5 in German, filed 7/19/01, and is thus under consideration.

Claims 1-9 are currently pending and under consideration.

### ***Information Disclosure Statement***

The Information Disclosure Statement filed 9/24/01 has been entered and references therein considered. Initialed copy of the form PTO-1449 is enclosed with this action.

### ***Foreign Priority***

Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Germany on July 20, 2000. Applicant has not complied with the requirements of 37 CFR 1.63(c). While the declaration filed 9/21/01 acknowledges the filing of the foreign application, it gives a wrong filing date: 20.07.01. A new oath, declaration or

Art Unit: 1631

application data sheet is required in the body of which the present application should be identified by the correct application number and filing date.

### *Specification*

The disclosure is objected to because of the following informalities:

The specification states on page 9 that “the propylene yields of the ten best catalysts of a generation are shown in Figure 2”, and on page 10, lines 2-4 that “Figure 2 shows that a reproducible increase in propylene yield of the most efficient catalyst...”. Examination of Figure 2 reveals that Figure 2 does show what it allegedly showed.

The use of the trademark NAG LIBRARY and NAG FORTRAN WORKSTATION LIBRARY on page 4 and other places, has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. The trademark on page 4, line 28, is not capitalized.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

It is noted that the specification on page 10 specifically refers to claim 1. It is suggested that the specification be amended not to refer to particular claim number since claims may be amended, canceled or renumbered during prosecution the application.

The specification refers to a German patent application DE 198 43 242.9 multiple times such as on page 1 and on page 10. The MPEP states: “references to foreign applications or to

Art Unit: 1631

applications identified only by the attorney's docket number should be required to be canceled (see MPEP 608.01):

Appropriate correction is required.

***Claim Rejections-35 USC § 112***

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-9 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The phrase “new catalysts” in claim 1 is vague and indefinite. It is not clear what catalysts are deemed new. The term is a relative term and absent a clear definition for the term in the specification, it is unclear how to determine a catalyst is new or old.

The phrase “the original catalysts and subsequent catalyst generations” recited in claim 1 and its dependent claims lacks clear antecedent basis. No “original catalysts” is recited earlier in the claim. Thus, the metes and bounds of the claim are unclear because it is not clear to what the term “original catalysts” is specifically referred. Further, the phrase “the respective catalyst generation” recited in claim 1 also lacks antecedent basis and is indefinite.

Further, claim 1, as currently written, does not appear to have active and positive steps delimiting how the claimed process is actually practiced. The essence of the claim is construed to be “a process of producing new catalysts ..., which comprises the fact that ...”. It is unclear from the claim as written whether the “fact” constitutes active steps for the claimed process.

Furthermore, claim 1 is generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The phrase “the gas stream” recited in claims 6 and 9 lacks antecedent basis and renders the claim indefinite. No “gas stream” is recited earlier in the claim or in claim 1, from which claim 6 depends.

Further, the phrase “the newly structured material compositions” recited in claims 6-9 lacks antecedent basis and is vague. It is unclear what is meant by the phrase.

The phrase “the space velocity of the gas” recited in claims 7 and 9 lacks antecedent basis and renders the claim indefinite. No “space velocity ” or “gas” is recited earlier in the claim or in claim 1, from which claim 6 depends.

The phrase “the next generation” (in claims 7-8) and “the next generations” (in claims 6 and 9) lack clear antecedent basis. It is unclear what is “the next generation” or “the next generations”, and what is the difference between the plural and the singular form of generations with regard to “the newly structured material compositions”.

The phrase “the temperature” recited in claims 8 and 9 lacks antecedent basis. It is unclear what temperature is referred to.

Furthermore, the phrase “the preferred number of generations” recited in claims 2-4 lacks clear antecedent basis. No number of generations is referred to in claim 1. The formula in claim 1 comprises  $i$  and  $j$  denoting the ranking of catalysts and  $n$  denoting the number of catalysts in one generation.

Claim 5 contains the trademark/trade name NAG LIBRARY and NAG FORTRAN WORKSTATION LIBRARY. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a limitation, i.e. the program codes of NAG LIBRARY, and the identification/description is indefinite.

Clarification of the metes and bounds of the claims is requested.

### ***Claim Rejections-35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As set forth above, the claimed process in claim 1 and its dependent claims, as currently written, does not appear to comprise active and positive steps delimiting the process. Thus, the claims are not proper process claims under 35 U.S.C. 101. See MPEP § 2173.05(q).

### *Claim Objections*

**Claim 8 is objected to because of the following informalities:**

The phrase “wherein the temperature is varied and the determination of the performance parameters of the newly structured material compositions of the next generation” in claim 8 is grammatically confusing. From what are claimed and phrased in claims 6-7, do applicants actually mean “wherein the temperature is varied in the determination of the performance parameters of the newly structured material compositions of the next generation”?

Appropriate correction is required.

### *Conclusion*

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.



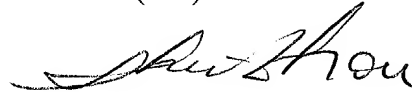
Art Unit: 1631

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "Shubo Zhou", written in black ink.

Shubo "Joe" Zhou, Ph.D.

Patent Examiner